

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Application No. 10/612,969

Atty. Docket No. Q76233

REMARKS

Claims 26 – 35 were previously pending, and claims 31, 32 and 34 are herein canceled. Accordingly, claims 26 – 30, 33 and 35 are presently pending.

While claims 26, 33 and 35 are herein amended, the claimed amendatory subject matter has been before the Examiner since at least the Amendment of July 20, 2004. Given that the noted amendatory subject matter has been before the Examiner, no new search should be required.

I. 35 U.S.C. § 112 Rejections

Claims 26, 33 and 35 are rejected under 35 U.S.C. § 112, for indefiniteness. Applicant submits that the claim amendments provided herein overcome this rejection.

II. 35 U.S.C. §§ 102 and 103 Rejections

Claims 26 – 32 and 35 are rejected under 35 U.S.C. § 102 in view of US 6,397,558 to Yuyama. Claims 33 and 34 are rejected under 35 U.S.C. § 103 in view of Yuyama. These rejections are respectfully traversed as explained below.

Applicant's claim 26 relates to an apparatus which assists users in their shopping experience. A person uses the apparatus to select a particular merchantable article from amongst a plurality of merchantable articles. The apparatus uses a bag size determination unit to select a shopping bag by determining the best fit of shopping bag for the particular article selected, prints the selected shopping bag with content associated with the particular article, and wraps the particular article with the printing medium (a shopping bag).

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Claim 26 thus sets forth a goods-wrapping apparatus which provides the user (a shopper) with a particular article wrapped by a shopping bag that is an appropriate size for the particular article selected by the user, and which includes content associated with the selected article printed on the appropriately sized shopping bag. The apparatus set forth by claim 26 thus provides for a satisfactory and rewarding shopping experience. While the Examiner compares the shopping apparatus set forth in Applicant's claim 26 to Yuyama's medicine dispenser, the comparison should be reconsidered and the instant rejections withdrawn for the reasons explained below.

A. Claimed Features Absent in the Yuyama Reference

1. A Shopping Bag

The Examiner compares Yuyama's medicine bags 10 (that are enclosed on all sides) to Applicant's independent claim 26 which sets forth a shopping bag. This comparison is inapposite.

Clearly, a shopping bag is open on one end and Yuyama's medicine bags 10 are entirely encapsulated (the medicine bags 10 necessarily must be closed on all sides to keep the powder 7 from leaving the containment provided by the medicine bags 10). Clearly Yuyama's medicine bags 10 are entirely enclosed without any opening. In contrast, a shopping bag will be given to a consumer with one end open. Because Applicant claims a shopping bag and not an entirely encapsulated medicine pouch, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection.

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2. A Determination Section

Applicant claims the subject matter of “a determination section for determining a size of said shopping bag among various sizes based on said particular article’s size.” These features are absent in the Yuyama reference.

Yuyama describes enclosing a powdered or encapsulated drug 7 in packing bags 10 to make a medicine belt 11 that can be used for delivery of dosed medicines to a patient over a period of time. *See* Fig. 1 and Columns 1 – 2, and particularly Column 2, lines 56 – 59. The packing paper 9 is folded in two in order to form the medicine bags 10. *Id.* Because the paper 9 is of one size and creates medicine bags of only one size, Yuyama fails to teach or suggest “determining a size of said shopping bag among various sizes based on said particular article’s size.” Because of these differences the Examiner is respectfully requested to reconsider and withdraw this rejection.

3. A Particular Article From Among a Plurality of Articles, Wherein the Particular Article is Selected by a User

Applicant claims the subject matter of *a user selecting a particular article from among a plurality of articles*. These features are absent in the Yuyama reference.

Yuyama describes an automated system for dispensing prescription drugs. The user of Yuyama’s drug dispenser does not decide which drugs to dispense. Indeed, a licensed pharmacist is required to dispense drugs as prescribed by a doctor. Even when taking into account the possibility that Yuyama’s user is a licensed pharmacist, however, the user is still not selecting a particular article from among a plurality of articles because a pharmacist filling the prescription is not the user of the items being dispensed.

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Moreover, in Yuyama's system a user does not select a particular article from among a plurality of articles. Yuyama's system merely dispenses whatever medicine has been prescribed by a doctor. *See* Col. 3, lines 39 – 42. Because of these differences, the Examiner is respectfully requested to reconsider and withdraw this rejection.

III. Dependent Claims

Applicant submits that dependent claims 27 – 30, 33 and 35 are patentable at least by virtue of their dependency upon claim 26.

IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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23493

CUSTOMER NUMBER

Date: December 20, 2004


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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this AMENDMENT UNDER 37 C.F.R. § 1.116 is being facsimile transmitted to the U.S. Patent and Trademark Office this 20th day of December, 2004.


Sanae Kusakabe